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Response dated: December 6, 2006
Appln. No. 10/658,499; Filed: September 9, 2003
Reply to Restriction Requirement of November 6, 2006

REMARKS

Claims 1-25 are currently pending. Of these, claims 21-25 have been withdrawn from consideration pursuant to a restriction requirement.

I. RESTRICTION REQUIREMENT

The Examiner required restriction between two inventions: (I) Claims 1-20, drawn to a prosthesis; and (II) Claims 21-25, drawn to a surgical method. In support of the restriction requirement, the Examiner asserted that Applicant's claimed vertebral body facet joint prosthesis "may be used as a finger joint prosthesis." (Examiner's Action at p. 3) Applicant hereby traverses the restriction requirement.

Claim 1 recites a prosthesis to replace all or a portion of a caudal portion of a natural facet joint on a vertebral body comprising a prosthesis body accommodating fixation to the vertebral body at or near a pedicle and without support by a lamina, and an artificial facet joint structure carried by the prosthesis body adapted and configured to replace all or a portion of a caudal portion of a natural facet joint. Claim 21 recites a method of replacing, on a vertebral body, all or a portion of a caudal portion of a natural facet joint *using the prosthesis defined in claim 1* to provide improved support for the spinal column, the method comprising the steps of (i) removing all or a portion of a natural articular process of the caudal portion of the natural facet joint from the vertebral body, and (ii) fixing the prosthesis as defined in claim 1 to the vertebral body to replace the removed portion of the natural articular process with the artificial facet joint structure (emphasis added). The Examiner's position that the vertebral body facet joint prosthesis of claim 1 can be used as a finger joint replacement despite the literal structural limitations recited by the claim is factually absurd and is an improper use of the restriction process. Applicant respectfully requests that the restriction requirement be withdrawn.

Notwithstanding Applicant's traversal of the requirement, Applicant hereby elects invention I, claims 1-20. Claims 21-25 have been provisionally indicated as being withdrawn from consideration pending resolution of the Examiner's improper restriction requirement.

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Applicant reserves the right pursuant to 35 U.S.C. § 121 to file one or more divisional applications directed to the non-elected invention during the pendency of the present application.

II. ELECTION REQUIREMENT

The Examiner stated that the application contains claims directed to patentably distinct species and required Applicants to elect one of them. The Examiner stated further that no claims are generic. In fact, however, many of the "species" the Examiner listed are not claimed at all. All claims are drawn to a prosthesis to replace all or a portion of a caudal portion of a natural facet joint on a vertebral body and methods of using such a caudal prosthesis. Figures 20, 29, 32 and 34 do not even show caudal prostheses. Furthermore, apparatus claims 1-11 and 18-20 and method claims 21-25 are generic to all claimed species, despite the Examiner's assertion to the contrary.

37 CFR 1.146 gives the Examiner the authority to require an election of species when the case has claims drawn to more than a reasonable number of species. In this case, the Examiner appears to have made no effort to determine whether all of the figures in his list of "species" actually had claims drawn to them. The Examiner has therefore not met the requirements of Rule 146. For these reasons, Applicant traverses the Examiner's election of species requirement.

Notwithstanding Applicant's traversal of the requirement, Applicant hereby elects the species identified by the Examiner as Figure 36. Apparatus claims 1-20 and method claims 21-25 read on this species. Applicant reserves the right pursuant to 35 U.S.C. § 121 to file one or more divisional applications directed to the non-elected species during the pendency of the present application.

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CONCLUSION

Applicant submits that this paper fully addresses the Office Action mailed November 6, 2006. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned attorney at 650.212.1700.

Respectfully submitted,

Dated: December 6, 2006



James R. Shay, Reg. No. 32,062

SHAY LAW GROUP LLP
2755 Campus Drive, Suite 210
San Mateo, CA 94403
Telephone: 650.212.1700
Facsimile: 650.212.7562

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